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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,626	10/24/2003	James S. W. Lee	200801-9013	8621
8968	7590	10/21/2005	EXAMINER	
GARDNER CARTON & DOUGLAS LLP ATTN: PATENT DOCKET DEPT. 191 N. WACKER DRIVE, SUITE 3700 CHICAGO, IL 60606			MILLER, BENA B	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/692,626

Applicant(s)

LEE ET AL.

Examiner

Bena Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 89,90,96,97,100,117,118,124,125,128,132,133,137,138 and 141-145 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 89,90,96,97,100,117,118,124,125,128,132,133,137,138 and 141-145 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

*Bena Miller*

## DETAILED ACTION

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 89, 90, 96, 97, 100, 117, 118, 124, 125, 128, 132, 133, 137, 138 and 141-145 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,830,497. The claims of the instant application recite most of the elements of the patented claims except the upper and lower torso member, a planar member, two shells and the second, third and fourth members comprising a material. However, it would have been obvious to delete these features from the toy figure in the patent for the purpose of making the toy figure more economical to produce.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 96, 97, 124 and 141-145 are rejected under 35 U.S.C. 102(b) as being anticipated by Pugh et al (US Patent 4,274,224), Delli Bovi et al (US Patent 4,738,649) or Goldberg et al (US Patent 4,708,687).

The device, as shown in the figures, of Pugh, Delli Bovi et al or Goldberg reads on the structural limitations of the claims including first and second shaft members (96, 46 or 58, respectively), a first member (34, 14, or 16, respectively), a second member (36), and a planar member (100 and 102, 42, or 70 respectively).

Claims 96, 100, 124, 128 and 141-145 are rejected under 35 U.S.C. 102(b) as being anticipated by Tilbor et al (US Patent 5,334,073).

The device, as shown in figures 1-11, of Tilbor reads on the structural limitations of the claims including first and second shaft members (29b), a first member (36), a second member (34), and a planar member (72).

Claims 96, 100, 124 and 141-145 are rejected under 35 U.S.C. 102(b) as being anticipated by Tenenbaum (US Patent 2,285,472).

The device, as shown in figures 1, of Tenenbaum reads on the structural limitations of the claims including first and second shaft members (33 and 34), a first member (31), a second member (27), and a planar member (37). It should be noted that Tenenbaum teaches in col. 4, par. 3, a cover 80 covers the legs and lower part of the torso of the structure.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 89, 90, 117, 118, 132 and 133 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tilbor in view of Pugh et al or Becker (US Patent 3,566,534).

Tilbor teaches in the figures most of the elements of the claimed invention including a third member (32) and a pin (fig.3). However, Tibor fails to teach the first member comprising two shells and a concealed means. Pugh et al and Becker teaches a toy doll having a leg wherein the upper portion of the leg is formed with two shells (fig 1 or fig. 4, respectively) and concealed means (22 and 38 or fig. 2, respectively). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate two shells and a concealed means as suggested by Pugh or Becker in the device of Tilber for the purpose of providing a realistic appearance for the leg in both its straight and bent positions.

Claims 89, 90, 117 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tenenbaum in view of Pugh et al or Becker (US Patent 3,566,534).

Tilbor teaches in the figures most of the elements of the claimed invention including a third member (22), a bore (the opening portion on the lower end 27—fig. 1) and a pin (25, it should be noted that pin 25 is inserted via 26). However, Tenenbaum fails to teach the first member comprising two shells and a concealed means. Pugh et

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al and Becker teaches a toy doll having a leg wherein the upper portion of the leg is formed with two shells (fig 1 or fig. 4, respectively) and concealed means (22 and 38 or fig. 2, respectively). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate two shells and a concealed means as suggested by Pugh or Becker in the device of Tenembaum for the purpose of providing a realistic appearance for the leg in both its straight and bent positions.

Claims 137 and 138 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tilbor in view of Becker (US Patent 3,566,534) and Delli Bovi et al (US Patent 4,738,649).

Tilbor teaches in the figures most of the elements of the claimed invention including a third member (32) and a pin (fig.3). However, Tilbor fails to teach the first member comprising two shells and a concealed means and the first, second and third material having melting points. Becker teaches a toy doll having a leg wherein the upper portion of the leg is formed with two shells (fig. 4, ) and concealed means (fig. 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate two shells and a concealed means as suggested by Becker in the device of Tilbor for the purpose of providing a realistic appearance for the leg in both its straight and bent positions.

Delli Bovi et al teach the concept of pieces of the toy being fabricated from different materials in col. 5, par. 5. It would have been obvious to one having ordinary skill in the art at the time the invention was made have different material with different

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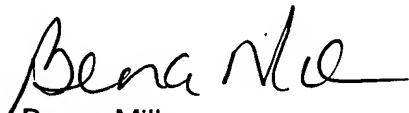
melting points as suggest by Delli Bovi members of Tilbor for the purpose of providing a realistic appearance for the leg in both its straight and bent positions.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bena Miller  
Primary Examiner  
Art Unit 3725

bbm  
October 18, 2005